



IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE  
REQUEST FOR REINSTATEMENT OF APPEAL  
In re Patent Application of:

# 16161  
for  
Reinstatement  
of Appeal  
of 03/26/01  
Upstat

Mark Rasper et al.

Serial No. 09/222,282

Filed: 12/29/99

Examiner: K. Tran

Art Unit: 3724

Supervisory Examiner: Rinaldi Rada

For: KNIFE INDEXING APPARATUS

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REQUEST FOR REINSTATEMENT OF APPEAL

This is a request for reinstatement of the appeal in the above described patent application.

The Notice of Appeal was filed on 08/14/00.

The Appeal brief was filed on 01/02/01.

A Supplementary Appeal Brief responsive to the grounds for rejection presented by the examiner in his office action of 03/26/01 and reasserting appellant's arguments presented in the brief of 01/02/01 / accompanies this request.

Submitted by

Russell L. Johnson

Patent agent (26,918)

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Weyauwega WI 54983

920/867-3482

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IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

17/ Apr  
Appeal  
Brief

In re Patent Application of:

Mark Rasper et al.

Serial No. 09/222,282

Filed: 12/29/99

Examiner: K. Tran

Art Unit: 3724

Supervisory Examiner: Rinaldi Rada

For: KNIFE INDEXING APPARATUS

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SUPPLEMENTAL APPEAL BRIEF

This is a Supplemental Appeal Brief filed in response to the Patent Office action of 03/26/01 (a copy of that action is provided in the Appendix as EXHIBIT R2). The action of 03/26/01 appears to reopen the prosecution in the above described patent application. The office action of 03/26/01 is responsive to the appellant's communication of 01/02/01 which is the filing of the appeal brief, the reinstatement of which the appellant has requested. A copy of a Request for Reinstatement of the Appeal is provided in the Appendix of this brief as EXHIBIT R1).

The office action of 03/26/01 does little to change the issues set forth in the appellant's brief of 01/02/01 and therefore that brief and its appendix is hereby incorporated herein by reference.

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What follows is the appellant's brief restatement of the issues addressed in the appeal brief of 01/02/01 with appropriate responses to the action of 03/26/01

#### REAL PARTY OF INTEREST

The real party of interest in this application is as stated in the brief of 01/02/01.

#### STATUS OF CLAIMS

The status of the claims is substantially the same as that set forth in the brief of 01/02/01

The action of 03/26/01 is substantially a restatement of the office action of 05/09/00 replacing Cavalli as a secondary reference with Kanbar (5,904,283).

#### STATUS OF AMENDMENTS

The status of the amendments is the same as that set forth in the brief of 01/02/01.

#### SUMMARY OF THE INVENTION

The summary of the invention is the same as that set forth in the brief of 01/02/01.

#### ISSUES

The issues to be decided by the board are the same as those set forth in the brief of 01/02/01 with the exception that in Issue #3, the name Cavelli is now replaced by the name Kanbar as the secondary reference in the examiner's 35 USC 103 rejection of claim 1.

#### GROUPING OF CLAIMS

The grouping of the claims is the same as that set forth in the brief of 01/02/01.

## ARGUMENTS

The appellant's arguments are substantially the same as those set forth in the brief of 01/02/01. They are briefly;

**Issue #1** Are the contents of a pending patent application available as prior art for 35 USC 103 purposes at the time a claimed invention is made? The appellant argues that the contents of a patent application that is pending at the time an invention is made are not available as prior art for 35 USC 103 purposes. The appellant requests that the board so find.

**Issue #2** Are the contents of an issued patent available for the purpose of the making of a 35 USC 103 rejection as of the filing date of that patent application? The appellant argues that they are not. The appellant requests that the board so find.

**Issue #3** Does Bailey, taken in view of Cavelli, or now, Bailey in view of Kanbar, have the capacity to render the appellants claim 1 obvious under 35 USC 103? The appellant argues that they do not.

The examiner's replacement of Cavelli with Kanbar does not cure the deficiencies of the examiner's cited prior art as noted in the brief of 01/02/01. Briefly stated they are;

- 1) Neither Bailey in view of Cavelli nor Bailey in view of Kanbar disclose or would motivate one skilled in the art to employ a worm and worm gear as a means for accurately indexing a non-rotating cutting tool as claimed by the appellants.

Neither Cavelli nor Kanabar are from the core cutting art nor are they from an analogous art. Neither of them contain within their four corners the mode of operation nor the end achieved by the worm and worm gear of this invention. They lack direction and motivation for one to consider a worm and worm gear for the purposes that they are employed in the instant invention to achieve the ends achieved by this invention.

These two critical factors are dealt with extensively in the brief of 01/02/01.

With the exception that Kanbar does show a worm gear acting in a non-analogous mode to the worm gear of this invention, the arguments presented in the brief of 01/02/01 apply to both Cavelli and Kanbar.

- 2) None of the references cited by the examiner evidence any knowledge of or potential for uncovering the appellants discovery that the direction of knife indexing is critical to knife efficiency and to the useful life of a knife as disclosed in the appellant's application and claimed as a restriction in appellants claim 1.

The examiner does not acknowledge the appellants claim to his invention as having critical improvements founded in a discovery. 35 USC 100(a) states 'the term "invention" means invention or discovery'. The last sentence of 35 USC 103(a) states, "Patentability shall not be negated by the manner in which the invention was made."

By the absence of any evidence of prior knowledge of the appellant's disclosed discovery or the potentials it presents, it is respectfully submitted that the prior art as a whole could not have rendered the appellants claim 1 obvious under 35 USC 103. The appellant asks that the board so find.

For the forgoing reasons, it is submitted that the examiner's rejections of the appellant's claim 1 are erroneous, and reversal of his decisions is respectfully requested

By



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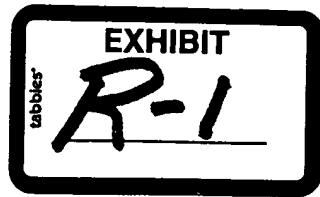


## APPENDIX

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IN THE UNITED STATES PATENT AND  
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REQUEST FOR REINSTATEMENT OF APPEAL  
In re Patent Application of;



Mark Rasper et al.

Serial No. 09/222,282

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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10/20/2000 10/20/2000 RAYMOND

RAYMOND  
P.O. BOX 1500  
KEYMARINE, MI 49062

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED:

10/27/00



Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/222,282	RASPER ET AL.
	Examiner Kim Tran	Art Unit 3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 January 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)                    18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    20) Other: *Attachment*.

## DETAILED ACTION

1. The Applicant's Appeals Brief has been acknowledged. However, upon further consideration and review, the Examiner has withdraw the previous office action, paper no. 6. The following is a new office action addressing claim 1.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Kanbar. Bailey discloses the invention substantially as claimed including a circular knife (47), mounting mandrel (38), index engaging means (col. 3, lines 4-9), and means for counting the cutting cycles, and activating the knife indexing means when a preset number of cutting cycles has been completed (col. 3, lines 57-67 and col. 4, lines 1-4). Bailey does not disclose a worm gear and worm shaft. However, Kanbar teaches a worm gear and worm shaft to drive the shaft of a roller (fig. 1, col. 3, lines 29-37). In view of Kanbar, it would have been obvious to one of ordinary skill in the art to provide the apparatus of Bailey with a worm gear and worm shaft to 1) element the need to manually drive the shaft (44) of Bailey which indexes the circular knife 2) it is well known in the art to provide a worm gear and worm shaft mechanism to generate rotary motion.

***Response to Arguments***

4. In response to Applicant's argument that Bailey was not available as a 35 USC 103(a) reference, the Examiner disagrees. The rejection is proper because Bailey, U.S. Patent No. 5,761,976 was **filed on April 15, 1997** and issued June 9, 1998 while applicant's invention claims priority of the Provisional Patent Application 60/070,405 **filed on January 1, 1998**. Bailey qualifies as a 35 U.S.C. 102(e) which relies on the **filings date**. Therefore, Bailey as a 35 U.S.C. 103 (a) reference is deemed proper.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Tran whose telephone number is 703-305-2597. The examiner can normally be reached on Monday through Friday from 8-5:30 pm.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-2597 for regular communications and 703-305-9835 for After Final communications.

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
knt  
March 20, 2001

  
Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700

<b>Notice of References Cited</b>		Application/Control No.	Applicant(s)/Patent Under Reexamination RASPER ET AL.	
		09/222,282	Examiner	Art Unit
		Kim Tran	3724	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-5,904,283-A	05-1999	Kanbar	225	
	B	US-5927175-A	07-1999	Franks et al.	83	
	C	US- -				
	D	US- -				
	E	US- -				
	F	US- -				
	G	US- -				
	H	US- -				
	I	US- -				
	J	US- -				
	K	US- -				
	L	US- -				
	M	US- -				

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	- -				
	O	- -				
	P	- -				
	Q	- -				
	R	- -				
	S	- -				
	T	- -				

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



TRANSMITTAL  
OF  
REQUEST FOR REINSTATEMENT OF APPEAL  
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Art Unit: 3724

Supervisory Examiner: Rinaldi Rada

For: KNIFE INDEXING APPARATUS

To the Commissioner of Patents and Trademarks

Washington D.C. 20231

Sir:

Transmitted herewith is a Request for Reinstatement of an appeal in the above-cited patent application. Also enclosed are;

- 1 Certificate of Mailing
- 3 Copies of a Supplemental Appeal Brief including an Appendix having a copy of the office action of 03/26/01 and the Request of Reinstatement
- 1 Self addressed post card

By

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

The Commissioner of Patents and Trademarks

Washington D.C. 20231

On 04/14/01

(Date)

Russell L. Johnson

(Name of person making deposit)

(Signature)

04/14/01

(Date)

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(4) any proposed disposition of surplus fees by  
office; and  
(5) such other information as the committees  
deems necessary.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 4, 89  
Stat. 3018; Dec. 12, 1980, Public Law 96-517, sec. 3, 94 Stat. 3018;  
July 27, 1982, Public Law 97-247, sec. 3(g), 96 Stat. 319 Sept.  
2, 1982; Public Law 97-258, sec. 3(i), 96 Stat. 1065.)

(Subsection (c) amended Dec. 10, 1991, Public Law  
104, sec. 5(e), 105 Stat. 1640.)

(Subsection (e) added Dec. 10, 1991, Public Law 102-204,  
105 Stat. 1637.)

## PART II – PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

### CHAPTER 10 – PATENTABILITY OF INVENTIONS

#### Definitions.

##### Inventions patentable.

##### Conditions for patentability; novelty and loss of right to patent.

##### Conditions for patentability; non-obvious subject matter.

##### Invention made abroad.

##### Inventions in outer space.

#### U.S.C. 100 Definitions.

When used in this title unless the context otherwise in-  
dicates—

- (a) The term "invention" means invention or  
process.
- (b) The term "process" means process, art, or  
method, and includes a new use of a known process,  
machine, manufacture, composition of matter, or mate-  
rial.
- (c) The terms "United States" and "this country"  
mean the United States of America, its territories and  
possessions.
- (d) The word "patentee" includes not only the  
patentee to whom the patent was issued but also the  
successors in title to the patentee.

#### U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful pro-  
cess, machine, manufacture, or composition of matter,  
any new and useful improvement thereof, may obtain  
a patent therefor, subject to the conditions and require-  
ments of this title.

#### 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in  
this country, or patented or described in a printed  
publication in this or a foreign country, before the  
invention thereof by the applicant for patent, or

(b) the invention was patented or described in a  
printed publication in this or a foreign country or in  
public use or on sale in this country, more than one year  
prior to the date of the application for patent in the  
United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to  
be patented, or was the subject of an inventor's  
certificate, by the applicant or his legal representatives  
or assigns in a foreign country prior to the date of the  
application for patent in this country on an application  
for patent or inventor's certificate filed more than twelve  
months before the filing of the application in the United  
States, or

(e) the invention was described in a patent  
granted on an application for patent by another filed in  
the United States before the invention thereof by the  
applicant for patent, or on an international application  
by another who has fulfilled the requirements of  
paragraphs (1), (2), and (4) of section 371(c) of this title  
before the invention thereof by applicant for patent, or

(f) he did not himself invent the subject matter  
sought to be patented, or

(g) before the applicant's invention thereof the  
invention was made in this country by another who had  
not abandoned, suppressed, or concealed it. In deter-  
mining priority of invention there shall be considered  
not only the respective dates of conception and reduc-  
tion to practice of the invention, but also the reasonable  
diligence of one who was first to conceive and last to  
reduce to practice, from a time prior to conception by the  
other.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat.  
501; Nov. 14, 1975, Public Law 94-131, sec. 3, 89 Stat. 691.)

#### 35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the  
invention is not identically disclosed or described as set  
forth in section 102 of this title, if the differences  
between the subject matter sought to be patented and